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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): KING.004CIP1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on July 24, 2008

Signature: _____

Typed or printed name: Steven R. Funk

Application Number	Filed
10/643,065	08/18/2003

First Named Inventor: BERMAN et al.

Art Unit	Examiner
3714	Mosser, R.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 37,830
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Steven R. Funk
Typed or printed name

952-854-2700
Telephone number

July 24, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	BERMAN et al.	Examiner:	Mosser, R.
Serial No.:	10/643,065	Group Art Unit:	3714
Filed:	August 18, 2003	Docket No.:	KING.004CIP1

Title: SYSTEM AND METHOD FOR EXECUTING TRADES FOR BONUS ACTIVITY IN GAMING SYSTEM

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 24, 2008.

By: _____
Steven R. Funk

APPELLANT'S STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellants in compliance with the USPTO OG Notice of 12 July 2005 entitled "New Pre-Appeal Brief Conference Pilot Program," which has been extended until further notice pursuant to the USPTO OG Notice of February 7, 2006. The Appellants are requesting a pre-appeal brief conference on the belief that the rejections of record are not proper and are based on a legal error. Thus, Appellants request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, this request for pre-appeal brief review is appropriate.

If an appeal becomes necessary, there may be issues other than those presented in this statement that may be addressed that may involve an interpretation of the claims or the teachings of the prior art. However, at this time, this statement involves claim limitations that the Appellants respectfully submit were disregarded or otherwise not given proper weight, which is inappropriate in a rejection based on 35 U.S.C. §102. The Appellants contend that the failure to

afford claim limitations their proper weight constitutes an appropriate basis for submitting the present statement in support of pre-appeal brief request for review.

The Appellants have reviewed the final rejection, and respectfully disagree that the *Mayeroff* reference anticipates Claims 1-16, 18-35 and 37-42. The Appellants contend that various claim limitations are not being accorded proper weight. While the Appellants understand that a claim can be given its "broadest reasonable interpretation," the Appellants submit that disregarding claimed recitations constitutes an error of law.

In the §102 rejection on pages 4-5 of the final Office Action, and again in the "Response to Arguments" on pages 8-9, the Examiner alleges that *Mayeroff* teaches receiving an indication to trade player assets for altering the odds of **receiving** at least one bonus activity. *Mayeroff* is cited at column 2, lines 46-53; column 4, lines 51-64, and column 7, lines 50-55. In these cited portions, and in *Mayeroff* in general, *Mayeroff* merely indicates that if a player *happens to* receive a secondary event, the number of plays of that secondary event may be influenced by the number of paylines played or wager amounts made by the player when playing the main game. In none of these cited portions, nor in *Mayeroff* generally, does *Mayeroff* indicate that there is any change in odds of receiving a "secondary event." Rather *Mayeroff* only describes that if the player, during the "main game," happens to get the right symbol combination in the main game (see, *e.g.*, Table 2, column 7 of *Mayeroff*), then the number of bonus plays may be tied to the number of paylines played or credits wagered.

In Claim 1 and other claims, the player is trading assets in order to change the odds of actually reaching/attaining a bonus or secondary event. As indicated in the Appellants' application (*e.g.*, page 3, lines 3-16, and page 7, lines 12-26), a player may want to "**bypass the normal odds of reaching a bonus round(s)** by trading player assets for **increased odds of reaching a bonus round(s)**." (Appellants's Specification, page 7, lines 25-26; emphasis added). In *Mayeroff*, differences in wagers for the main game only impact how many bonus spins the player will get if the player reaches the secondary event under normal, unaltered odds. For example, *Mayeroff* notes in column 7, lines 49-55 that if a player "would achieve" (by way of unaltered odds) three cherries on an active payline, the "number of bonus spins on the secondary reel could be three spins." This does not, however, teach increasing or otherwise altering the odds of actually getting to the secondary reel. It is therefore respectfully submitted that the claimed

recitations of altering the odds of actually receiving a bonus or secondary gaming activity(s) are not taught, or suggested, by *Mayeroff*.

Additionally, the Appellants previously argued that *Mayeroff* does not involve trading player assets for altering the odds of receiving a bonus event(s). To anticipate a claim, the reference must teach every element of the claim. Importantly, "[t]he identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claim 1 includes a) receiving an indication to trade player assets for altering the odds...; and 2) receiving an identification of a trade value offered by the player. The Examiner ostensibly takes the position that *Mayeroff*'s playing additional paylines or wagering a higher amount on each played payline teaches both of these limitations. It is respectfully submitted that because there is no "trade for" any bonus or secondary activity in *Mayeroff*, there is no need for (nor is there any disclosure of) **receiving an indication to trade** player assets **for** altering the odds of receiving a bonus activity(s). In other words, the Appellants contend that any increased number of spins in *Mayeroff*'s secondary event is not a result of a trade for those increased number of spins, but rather is a wager for the main gain that may incidentally result in an increased number of spins in the secondary event. There is no ***indication*** received that reveals the player's affirmative desire to trade his/her credits or other assets in return for altered odds of receiving a bonus activity (or additionally, in *Mayeroff*'s case, to change the number of spins on *Mayeroff*'s secondary reels). The wager played by the *Mayeroff* player only indicates how many paylines of the main game he/she wants to play, and/or how much money he/she wants to play for each payline of the main game. It is only an incidental result based on unaltered odds of the main game whether the *Mayeroff* player gets more spins in the secondary event. Thus, there is no *indication received* by the *Mayeroff* gaming system that would, as a result of receiving this indication, alter the odds of receiving the *Mayeroff* secondary game.

Thus, the Appellants maintain the prior argument that in *Mayeroff*, the player is not trading assets for altering the odds of receiving a bonus activity(s), but rather the *Mayeroff* player is wagering assets for participating in *Mayeroff*'s main game. In Claim 1, the player gives up something (assets) that does not pay for any actual participation in a gaming event. The money is paid, the odds of receiving a bonus event(s) is altered, and then the player must additionally make a standard wager (as in *Mayeroff*) to play the standard game. In *Mayeroff* the player always pays

to play, and specifically, to play the main game. Thus, the Appellants maintain that *Mayeroff* does not teach trading assets for getting an increased number of spins in *Mayeroff*'s secondary event, but rather describes trading player assets to play the main game that might incidentally provide a higher number of spins if the player reaches (via unaltered odds) the secondary event.

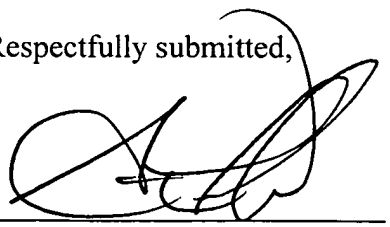
The Examiner's rejection and rationale was applied to each of the pending independent claims. Therefore, the above arguments are applicable in an analogous fashion to other independent claims that include limitations analogous to those argued above. Similarly, each of the pending dependent claims include all of the limitations of their respective independent claim and any intervening claims, and the arguments above are equally applicable to each of the dependent claims. Regarding the rejection of Claims 17 and 36 under 35 U.S.C. §103, these rejections rely on the *Mayeroff* reference as teaching the claim recitations of those claims from which Claims 17 and 36 are dependent, and therefore the arguments above are equally applicable to the deficiencies of the *Mayeroff* reference.

The Appellants note that these are not issues of claim interpretation, but rather issues of whether the Office is giving weight to limitations expressly set forth in the claims. The Appellants respectfully submit that claimed limitations are not being given the proper weight by the Office during prosecution, and discounting such claim limitations results in an error of law.

Notwithstanding other potential issues for appeal that are outside the scope of this statement in support of pre-appeal request for review, at least the aforementioned limitations have not been properly considered. For at least these reasons, the rejections based on *Mayeroff* are grounded in an error of law. The Appellant respectfully submits that the resulting error of law compels reversal of these rejections.

The undersigned attorney of record may be contacted at 952.854.2700 (ext. 11) to discuss any issues related to this case.

Respectfully submitted,



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